

103D CONGRESS
1ST SESSION

S. 977

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

IN THE SENATE OF THE UNITED STATES

MAY 18 (legislative day, APRIL 19), 1993

Mr. DECONCINI introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend the Trademark Act of 1946 to provide for the registration and protection of trademarks used in commerce, in order to carry out provisions of certain international conventions, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Madrid Protocol Imple-
5 mentation Act”.

1 **SEC. 3. PROVISIONS TO IMPLEMENT THE PROTOCOL RE-**
2 **LATING TO THE MADRID AGREEMENT CON-**
3 **CERNING THE INTERNATIONAL REGISTRA-**
4 **TION OF MARKS.**

5 The Act entitled “An Act to provide for the registra-
6 tion and protection of trade-marks used in commerce, to
7 carry out the provisions of certain international conven-
8 tions, and for other purposes”, approved July 5, 1946, as
9 amended (15 U.S.C. 1051 and following) (commonly re-
10 ferred to as the “Trademark Act of 1946”) is amended
11 by adding after section 51 the following new title:

12 “TITLE XII—THE MADRID PROTOCOL

13 **“SEC. 60. DEFINITIONS.**

14 “For purposes of this title:

15 “(1) MADRID PROTOCOL.—The term ‘Madrid
16 Protocol’ means the Protocol Relating to the Madrid
17 Agreement Concerning the International Registra-
18 tion of Marks, adopted at Madrid, Spain, on June
19 27, 1989.

20 “(2) BASIC APPLICATION.—The term ‘basic ap-
21 plication’ means the application for the registration
22 of a mark that has been filed with an Office of a
23 Contracting Party and that constitutes the basis for
24 an application for the international registration of
25 that mark.

1 “(3) BASIC REGISTRATION.—The term ‘basic
2 registration’ means the registration of a mark that
3 has been granted by an Office of a Contracting
4 Party and that constitutes the basis for an applica-
5 tion for the international registration of that mark.

6 “(4) CONTRACTING PARTY.—The term ‘Con-
7 tracting Party’ means any country or inter-govern-
8 mental organization that is a party to the Madrid
9 Protocol.

10 “(5) DATE OF RECORDAL.—The term ‘date of
11 recordal’ means the date on which a request for ex-
12 tension of protection that is filed after an inter-
13 national registration is granted is recorded on the
14 International Register.

15 “(6) DECLARATION OF BONA FIDE INTENTION
16 TO USE THE MARK IN COMMERCE.—The term ‘dec-
17 laration of bona fide intention to use the mark in
18 commerce’ means a declaration that is signed by the
19 applicant for, or holder of, an international registra-
20 tion who is seeking extension of protection of a mark
21 to the United States and that contains a statement
22 that—

23 “(A) the applicant or holder has a bona
24 fide intention to use the mark in commerce,

1 “(B) the person making the declaration be-
2 lieves himself or herself, or the firm, corpora-
3 tion, or association in whose behalf he or she
4 makes the declaration, to be entitled to use the
5 mark in commerce, and

6 “(C) no other person, firm, corporation, or
7 association, to the best of his or her knowledge
8 and belief, has the right to use such mark in
9 commerce either in the identical form of the
10 mark or in such near resemblance to the mark
11 as to be likely, when used on or in connection
12 with the goods of such other person, firm, cor-
13 poration, or association, to cause confusion, or
14 to cause mistake, or to deceive.

15 “(7) EXTENSION OF PROTECTION.—The term
16 ‘extension of protection’ means the protection result-
17 ing from an international registration that extends
18 to a Contracting Party at the request of the holder
19 of the international registration, in accordance with
20 the Madrid Protocol.

21 “(8) HOLDER OF AN INTERNATIONAL REG-
22 ISTRATION.—A ‘holder’ of an international registra-
23 tion is the natural or juristic person in whose name
24 the international registration is recorded on the
25 International Register.

1 “(9) INTERNATIONAL APPLICATION.—The term
2 ‘international application’ means an application for
3 international registration that is filed under the Ma-
4 drid Protocol.

5 “(10) INTERNATIONAL BUREAU.—The term
6 ‘International Bureau’ means the International Bu-
7 reau of the World Intellectual Property Organiza-
8 tion.

9 “(11) INTERNATIONAL REGISTER.—The term
10 ‘International Register’ means the official collection
11 of such data concerning international registrations
12 maintained by the International Bureau that the
13 Madrid Protocol or its implementing regulations re-
14 quire or permit to be recorded, regardless of the me-
15 dium which contains such data.

16 “(12) INTERNATIONAL REGISTRATION.—The
17 term ‘international registration’ means the registra-
18 tion of a mark granted under the Madrid Protocol.

19 “(13) INTERNATIONAL REGISTRATION DATE.—
20 The term ‘international registration date’ means the
21 date assigned to the international registration by the
22 International Bureau.

23 “(14) NOTIFICATION OF REFUSAL.—The term
24 ‘notification of refusal’ means the notice sent by an
25 Office of a Contracting Party to the International

1 Bureau declaring that an extension of protection
2 cannot be granted.

3 “(15) OFFICE OF A CONTRACTING PARTY.—The
4 term ‘Office of a Contracting Party’ means—

5 “(A) the office, or governmental entity, of
6 a Contracting Party that is responsible for the
7 registration of marks, or

8 “(B) the common office, or governmental
9 entity, of more than 1 Contracting Party that
10 is responsible for the registration of marks and
11 is so recognized by the International Bureau.

12 “(16) OFFICE OF ORIGIN.—The term ‘office of
13 origin’ means the Office of a Contracting Party with
14 which a basic application was filed or by which a
15 basic registration was granted.

16 “(17) OPPOSITION PERIOD.—The term ‘opposi-
17 tion period’ means the time allowed for filing an op-
18 position in the Patent and Trademark Office, includ-
19 ing any extension of time granted under section 13.

20 **“SEC. 61. INTERNATIONAL APPLICATIONS BASED ON UNIT-**
21 **ED STATES APPLICATIONS OR REGISTRA-**
22 **TIONS.**

23 “The owner of a basic application pending before the
24 Patent and Trademark Office, or the owner of a basic reg-
25 istration granted by the Patent and Trademark Office,

1 may file an international application by submitting to the
2 Patent and Trademark Office a written application in
3 such form, together with such fees, as may be prescribed
4 by the Commissioner.

5 **“SEC. 62. CERTIFICATION OF THE INTERNATIONAL APPLI-**
6 **CATION.**

7 “Upon the filing of an application for international
8 registration and payment of the prescribed fees, the Com-
9 missioner shall examine the international application for
10 the purpose of certifying that the information contained
11 in the international application corresponds to the infor-
12 mation contained in the basic application or basic registra-
13 tion at the time of the certification. Upon examination and
14 certification of the international application, the Commis-
15 sioner shall transmit the international application to the
16 International Bureau.

17 **“SEC. 63. RESTRICTION, ABANDONMENT, CANCELLATION,**
18 **OR EXPIRATION OF A BASIC APPLICATION OR**
19 **BASIC REGISTRATION.**

20 “With respect to an international application trans-
21 mitted to the International Bureau under section 62, the
22 Commissioner shall notify the International Bureau when-
23 ever the basic application or basic registration which is
24 the basis for the international application has been re-
25 stricted, abandoned, or canceled, or has expired, with re-

1 spect to some or all of the goods and services listed in
2 the international registration—

3 “(1) within 5 years after the international reg-
4 istration date; or

5 “(2) more than 5 years after the international
6 registration date if the restriction, abandonment, or
7 cancellation of the basic application or basic reg-
8 istration resulted from an action that began before
9 the end of that 5-year period.

10 **“SEC. 64. REQUEST FOR EXTENSION OF PROTECTION SUB-**
11 **SEQUENT TO INTERNATIONAL REGISTRA-**
12 **TION.**

13 “The holder of an international registration that is
14 based upon a basic application filed with the Patent and
15 Trademark Office or a basic registration granted by the
16 Patent and Trademark Office may request an extension
17 of protection of its international registration by filing such
18 a request—

19 “(1) directly with the International Bureau, or

20 “(2) with the Patent and Trademark Office for
21 transmittal to the International Bureau, if the re-
22 quest is in such form, and contains such transmittal
23 fee, as may be prescribed by the Commissioner.

1 **“SEC. 65. EXTENSION OF PROTECTION OF AN INTER-**
2 **NATIONAL REGISTRATION TO THE UNITED**
3 **STATES UNDER THE MADRID PROTOCOL.**

4 “(a) IN GENERAL.—Subject to the provisions of sec-
5 tion 68, the holder of an international registration shall
6 be entitled to the benefits of extension of protection of that
7 international registration to the United States to the ex-
8 tent necessary to give effect to any provision of the Madrid
9 Protocol.

10 “(b) IF UNITED STATES IS OFFICE OF ORIGIN.—An
11 extension of protection resulting from an international
12 registration of a mark shall not apply to the United States
13 if the Patent and Trademark Office is the office of origin
14 with respect to that mark.

15 **“SEC. 66. EFFECT OF FILING A REQUEST FOR EXTENSION**
16 **OF PROTECTION OF AN INTERNATIONAL**
17 **REGISTRATION TO THE UNITED STATES.**

18 “(a) REQUIREMENT FOR REQUEST FOR EXTENSION
19 OF PROTECTION.—A request for extension of protection
20 of an international registration to the United States that
21 the International Bureau transmits to the Patent and
22 Trademark Office shall be deemed to be properly filed in
23 the United States if such request, when received by the
24 International Bureau, has attached to it a declaration of
25 bona fide intention to use the mark in commerce that is

1 verified by the applicant for, or holder of, the international
2 registration.

3 “(b) EFFECT OF PROPER FILING.—Unless extension
4 of protection is refused under section 68, the proper filing
5 of the request for extension of protection under subsection
6 (a) shall constitute constructive use of the mark, confer-
7 ring the same rights as those specified in section 7(c), as
8 of the earliest of the following:

9 “(1) The international registration date, if the
10 request for extension of protection was filed in the
11 international application.

12 “(2) The date of recordal of the request for ex-
13 tension of protection, if the request for extension of
14 protection was made after the international registra-
15 tion date.

16 “(3) The date of priority claimed pursuant to
17 section 67.

18 **“SEC. 67. RIGHT OF PRIORITY FOR REQUEST FOR EXTEN-**
19 **SION OF PROTECTION TO THE UNITED**
20 **STATES.**

21 “The holder of an international registration with an
22 extension of protection to the United States shall be enti-
23 tled to claim a date of priority based on the right of prior-
24 ity within the meaning of Article 4 of the Paris Convention
25 for the Protection of Industrial Property if—

1 “(1) the international registration contained a
2 claim of such priority; and

3 “(2)(A) the international application contained
4 a request for extension of protection to the United
5 States, or

6 “(B) the date of recordal of the request for ex-
7 tension of protection to the United States is not
8 later than 6 months after the date of the first regu-
9 lar national filing (within the meaning of Article
10 4(A)(3) of the Paris Convention for the Protection
11 of Industrial Property) or a subsequent application
12 (within the meaning of Article 4(C)(4) of the Paris
13 Convention).

14 **“SEC. 68. EXAMINATION OF AND OPPOSITION TO REQUEST**
15 **FOR EXTENSION OF PROTECTION; NOTIFICA-**
16 **TION OF REFUSAL.**

17 “(a) EXAMINATION AND OPPOSITION.—(1) A request
18 for extension of protection described in section 66(a) shall
19 be examined as an application for registration on the Prin-
20 cipal Register under this Act, and if on such examination
21 it appears that the applicant is entitled to extension of
22 protection under this title, the Commissioner shall cause
23 the mark to be published in the Official Gazette of the
24 Patent and Trademark Office.

1 “(2) Subject to the provisions of subsection (c), a re-
2 quest for extension of protection under this title shall be
3 subject to opposition under section 13. Unless successfully
4 opposed, the request for extension of protection shall not
5 be refused.

6 “(3) Extension of protection shall not be refused
7 under this section on the ground that the mark has not
8 been used in commerce.

9 “(4) Extension of protection shall be refused under
10 this section to any mark not registrable on the Principal
11 Register.

12 “(b) NOTIFICATION OF REFUSAL.—If, a request for
13 extension of protection is refused under subsection (a), the
14 Commissioner shall declare in a notification of refusal (as
15 provided in subsection (c)) that the extension of protection
16 cannot be granted, together with a statement of all
17 grounds on which the refusal was based.

18 “(c) NOTICE TO INTERNATIONAL BUREAU.—(1)
19 Within 18 months after the date on which the Inter-
20 national Bureau transmits to the Patent and Trademark
21 Office a notification of a request for extension of protec-
22 tion, the Commissioner shall transmit to the International
23 Bureau any of the following that applies to such request:

24 “(A) A notification of refusal based on an ex-
25 amination of the request for extension of protection.

1 “(B) A notification of refusal based on the fil-
2 ing of an opposition to the request.

3 “(C) A notification of the possibility that an op-
4 position to the request may be filed after the end of
5 that 18-month period.

6 “(2) If the Commissioner has sent a notification of
7 the possibility of opposition under paragraph (1)(C), the
8 Commissioner shall, if applicable, transmit to the Inter-
9 national Bureau a notification of refusal on the basis of
10 the opposition, together with a statement of all the
11 grounds for the opposition, within 7 months after the be-
12 ginning of the opposition period or within 1 month after
13 the end of the opposition period, whichever is earlier.

14 “(3) If a notification of refusal of a request for exten-
15 sion of protection is transmitted under paragraph (1) or
16 (2), no grounds for refusal of such request other than
17 those set forth in such notification may be transmitted to
18 the International Bureau by the Commissioner after the
19 expiration of the time periods set forth in paragraph (1)
20 or (2), as the case may be.

21 “(4) If a notification specified in paragraph (1) or
22 (2) is not sent to the International Bureau within the time
23 period set forth in such paragraph, with respect to a re-
24 quest for extension of protection, the request for extension
25 of protection shall not be refused and the Commissioner

1 shall issue a certificate of extension of protection pursuant
2 to the request.

3 “(d) DESIGNATION OF AGENT FOR SERVICE OF
4 PROCESS.—In responding to a notification of refusal with
5 respect to a mark, the holder of the international registra-
6 tion of the mark shall designate, by a written document
7 filed in the Patent and Trademark Office, the name and
8 address of a person resident in the United States on whom
9 may be served notices or process in proceedings affecting
10 the mark. Such notices or process may be served upon
11 the person so designated by leaving with that person, or
12 mailing to that person, a copy thereof at the address speci-
13 fied in the last designation so filed. If the person so des-
14 igned cannot be found at the address given in the last
15 designation, such notice or process may be served upon
16 the Commissioner.

17 **“SEC. 69. EFFECT OF EXTENSION OF PROTECTION.**

18 “(a) ISSUANCE OF EXTENSION OF PROTECTION.—
19 Unless a request for extension of protection is refused
20 under section 68, the Commissioner shall issue a certifi-
21 cate of extension of protection pursuant to the request and
22 shall cause notice of such certificate of extension of protec-
23 tion to be published in the Official Gazette of the Patent
24 and Trademark Office.

1 “(b) EFFECT OF EXTENSION OF PROTECTION.—
 2 From the date on which a certificate of extension of pro-
 3 tection is issued under subsection (a)—

4 “(1) such extension of protection shall have the
 5 same effect and validity as a registration on the
 6 Principal Register, and

7 “(2) the holder of the international registration
 8 shall have the same rights and remedies as the
 9 owner of a registration on the Principal Register.

10 **“SEC. 70. DEPENDENCE OF EXTENSION OF PROTECTION TO**
 11 **THE UNITED STATES ON THE UNDERLYING**
 12 **INTERNATIONAL REGISTRATION.**

13 “(a) EFFECT OF CANCELLATION OF INTERNATIONAL
 14 REGISTRATION.—If the International Bureau notifies the
 15 Patent and Trademark Office of the cancellation of an
 16 international registration with respect to some or all of
 17 the goods and services listed in the international registra-
 18 tion, the Commissioner shall cancel any extension of pro-
 19 tection to the United States with respect to such goods
 20 and services as of the date on which the international reg-
 21 istration was canceled.

22 “(b) EFFECT OF FAILURE TO RENEW INTER-
 23 NATIONAL REGISTRATION.—If the International Bureau
 24 does not renew an international registration, the cor-
 25 responding extension of protection to the United States

1 shall cease to be valid as of the date of the expiration of
2 the international registration.

3 “(c) TRANSFORMATION OF AN EXTENSION OF PRO-
4 TECTION INTO A UNITED STATES APPLICATION.—The
5 holder of an international registration canceled in whole
6 or in part by the International Bureau at the request of
7 the office of origin, under Article 6(4) of the Madrid Pro-
8 tocol, may file an application, under section 1 or 44 of
9 this Act, for the registration of the same mark for any
10 of the goods and services to which the cancellation applies
11 that were covered by an extension of protection to the
12 United States based on that international registration.
13 Such an application shall be treated as if it had been filed
14 on the international registration date or the date of
15 recordal of the request for extension of protection with the
16 International Bureau, whichever date applies, and, if the
17 extension of protection enjoyed priority under section 67
18 of this title, shall enjoy the same priority. Such an applica-
19 tion shall be entitled to the benefits conferred by this sub-
20 section only if the application is filed not later than 3
21 months after the date on which the international registra-
22 tion was canceled, in whole or in part, and only if the ap-
23 plication complies with all the requirements of this Act
24 which apply to any application filed pursuant to section
25 1 or 44.

1 **“SEC. 71. AFFIDAVITS AND FEES.**

2 “(a) REQUIRED AFFIDAVITS AND FEES.—An exten-
3 sion of protection for which a certificate of extension of
4 protection has been issued under section 69 shall remain
5 in force for the term of the international registration upon
6 which it is based, except that the extension of protection
7 of any mark shall be canceled by the Commissioner—

8 “(1) at the end of the 6-year period beginning
9 on the date on which the certificate of extension of
10 protection was issued by the Commissioner, unless
11 within the 1-year period preceding the expiration of
12 that 6-year period the holder of the international
13 registration files in the Patent and Trademark Of-
14 fice an affidavit under subsection (b) together with
15 a fee prescribed by the Commissioner; and

16 “(2) at the end of the 10-year period beginning
17 on the date on which the certificate of extension of
18 protection was issued by the Commissioner, and at
19 the end of each 10-year period thereafter, unless—

20 “(A) within the 6-month period preceding
21 the expiration of such 10-year period the holder
22 of the international registration files in the Pat-
23 ent and Trademark Office an affidavit under
24 subsection (b) together with a fee prescribed by
25 the Commissioner; or

1 “(B) within 3 months after the expiration
2 of such 10-year period, the holder of the inter-
3 national registration files in the Patent and
4 Trademark Office an affidavit under subsection
5 (b) together with the fee described in subpara-
6 graph (A) and an additional fee prescribed by
7 the Commissioner.

8 “(b) CONTENTS OF AFFIDAVIT.—The affidavit re-
9 ferred to in subsection (a) shall set forth those goods or
10 services recited in the extension of protection on or in con-
11 nection with which the mark is in use in commerce and
12 the holder of the international registration shall attach to
13 the affidavit a specimen or facsimile showing the current
14 use of the mark in commerce, or shall set forth that any
15 nonuse is due to special circumstances which excuse such
16 nonuse and is not due to any intention to abandon the
17 mark. Special notice of the requirement for such affidavit
18 shall be attached to each certificate of extension of protec-
19 tion.

20 **“SEC. 72. ASSIGNMENT OF AN EXTENSION OF PROTECTION.**

21 “An extension of protection may be assigned, to-
22 gether with the goodwill associated with the mark, only
23 to a person who is a national of, is domiciled in, or has
24 a bona fide and effective industrial or commercial estab-
25 lishment either in a country that is a Contracting Party

1 or in a country that is a member of an intergovernmental
2 organization that is a Contracting Party.

3 **“SEC. 73. INCONTESTABILITY.**

4 “The period of continuous use prescribed under sec-
5 tion 15 for a mark covered by an extension of protection
6 issued under this title may begin no earlier than the date
7 on which the Commissioner issues the certificate of the
8 extension of protection by under section 69.”.

9 **SEC. 4. EFFECTIVE DATE.**

10 This Act shall take effect on the date on which the
11 Madrid Protocol enters into force with respect to the Unit-
12 ed States.

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